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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/177,047 10/22/98 BRINKLEY

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PM82/1114

EXAMINER

JOHNSON, S

ART UNIT

PAPER NUMBER

3641

DATE MAILED:

11/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/177,047

Applicant(s)
Kenneth L. Brinkley

Examiner
Stephen M. Johnson

Group Art Unit
3641



☒ Responsive to communication(s) filed on Aug 29, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 22, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Aug 29, 2000 is ☐ approved ☒ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The proposed drawing corrections filed on 8/29/2000 have been disapproved. In reissue cases, amendments to the original drawings are not permitted. (see 37 CFR 1.121(b)(3)(I)).
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the audible display (claim 3) and the compass display (claim 31) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the accelerometer (see claims 25, 27, and 30) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.
5. Claims 1-13, 22-27, 31, 38, and 40-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of the claim is inconsistent with the body of the claim language. The preamble is directed to the subcombination (a firearm monitoring device) whereas the body of the claim is directed to the combination (a firearm monitoring device in combination with a firearm). This makes the claim language indefinite as to intended breadth. Applicant is required to clarify

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whether the claims are intended to be directed to the subcombination or the combination and to amend the claims consistent with the intent.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 29 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson.

Johnson discloses a device for counting pulses comprising:

- | | |
|--|---------------------|
| a) an inertia sensor, | 34 |
| b) an electrical circuit, | 30 |
| c) signal indicative of number of pulses, and | 40 |
| d) disregard signals after a predetermined time. | col. 4, lines 20-28 |

8. Claims 28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthews.

Matthews discloses a device for counting pulses comprising:

- | | |
|---|--------|
| a) an inertia sensor, | 134 |
| b) an electrical circuit, and | 26 |
| c) signal indicative of number of pulses. | 26, 64 |

9. Claims 1-2, 4-6, 9, 14-15, 18, 21, 28, and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al..

Johnson et al. disclose a device for counting pulses comprising:

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- | | |
|---|----------------------------|
| a) an inertia sensor, | 36, 38, or 50, 52 or
28 |
| b) an electrical circuit, | 12, 14, 32, 34 |
| c) signal indicative of number of pulses, and | 10 |
| d) a cylindrical housing. | see fig. 3 |

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Matthews.

Johnson et al. apply as recited above. However, undisclosed is a spring for returning the inertia switch. Matthews teaches a spring for returning the inertia switch (see fig. 5). Applicant is selecting a particular means for returning an inertia switch for the undisclosed means for returning an inertia switch of Johnson et al.. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Matthews to the Johnson et al. device and have a device with a particular means for returning the inertia switch.

12. Claims 27, 30, 36-37, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Haug Jr..

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Johnson et al. apply as recited above. However, undisclosed is an inertia switch that is an accelerometer. Haug Jr. teaches an inertia switch that is an accelerometer 28. Applicant is substitution one inertia switch for another in an analogous art setting as explicitly encouraged by the primary reference (see col. 3, lines 18-20 of Johnson et al.). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Haug Jr. to the Johnson et al. device and have a device with a different type of inertia switch.

13. Claims 1-2, 4-24, 26, 28-29, 32-35, and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Horne et al. (307).

Horne et al. (307) disclose a device for counting pulses comprising:

- | | |
|---|---------------------|
| a) an inertia sensor, | 28, 28b, 32 |
| b) an electrical circuit, | 50 |
| c) signal indicative of number of pulses, and | 24 |
| d) disregard signals in predetermined time. | col. 5, lines 44-62 |

14. Claims 28, 30, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Thornton.

Thornton discloses a device for counting pulses comprising:

- | | |
|---|-------------|
| a) an inertia sensor (accelerometer), | 16, 17 |
| b) an electrical circuit, and | see fig. 2' |
| c) signal indicative of number of pulses. | 114 |

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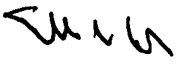
15. Claims 1-41 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter because the claim language is directed to subject matter surrendered in the original application by changes made to the claims in an effort to overcome a prior art rejection and/or arguments made in an effort to overcome the prior art. (See Clement 131 F.3d at 1469, 45 USPQ2d at 1164).

This is in regard to the claim language added by amendment filed on 2/20/96 as follows:
“for attaching to a firearm, said firearm having a firing end and a grip end, and”; and
“wherein said first means comprise an inertia switch comprising a movable mass; and wherein said mass is resiliently biased toward the firing end of the firearm”.

This is also in regard to the arguments filed on 2/20/96 directed to “the movable mass is resiliently biased toward the firing end of the firearm”.

16. Applicant's arguments with respect to claims 27-28 and 30-31 have been considered but are moot in view of the new ground(s) of rejection.

17. Any inquiry concerning this communication should be directed to Stephen M. Johnson at telephone number (703)-306-4158.


STEPHEN M. JOHNSON
PRIMARY EXAMINER